

REMARKS

The Office Action mailed December 27, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Rejection(s) Under 35 U.S.C. § 103(a)

Claims 1 – 3, 5, 7, 8 – 10, 12 – 18 and 22 - 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hanawa et al. (U.S. pat. no. 5,890,077) in view of Barber (U.S. pat. no. 6,230,031).

Claim 1 has been amended to recite a radio modem unit, an RF signal booster unit, and auto-detect logic. Claim 1 expressly states that the booster unit “is connectable to the radio modem unit with *a connector adapted to transmit RF signals through a connection line capable of carrying a DC offset*” (emphasis added), and that the auto-detect logic detects the DC offset “in order to determine whether the booster unit is connected to the radio modem.”

Hanawa et al. does not disclose an RF connection between a modem and a booster because telephone 11 and booster 12 of Hanawa et al. each has its own transmitter/receive and its own antenna. There is therefore no need to send RF signals between the two devices, or to use a connector having a connection line adapted to carry an RF signal and a DC offset in Hanawa et al.

Barber similarly does not use a connector having a connection line adapted to carry an RF signal and a DC offset. Rather, Barber relies on separate connections, which are described as follows:

The connections between the radio transceiver 30, the holder 32, and the booster amplifier 40 include, at least, signaling connections and a coaxial cable for passing RF signals to and from the radio transceiver 30. (Emphasis added).

Barber, col. 4, ll. 3 – 6.

Since the “connector adapted to transmit RF signals through a connection line capable of carrying a DC offset” of Claim 1 is missing from both Hanawa et al. and Barber, the combination of these two references, even if proper, would not result in the claimed invention.

The Examiner is reminded that one of the criteria for a *prima facie* case of obviousness is that the references, when combined, must teach or suggest *all* the claim limitations.¹ This is not the case with the combination of Hanawa et al. and Barber, which fails to teach or suggest a “connector adapted to transmit RF signals through a connection line capable of carrying a DC offset.” Therefore the Office Action fails to make a *prima facie* case of obviousness of Claim 1, Claim 8 which has been similarly amended, Claims 2 – 7 dependent from Claim no. 1, and Claims 10 – 12 dependent from Claim 8.

¹ To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. MPEP § 2143, emphasis added.

Independent Claims 13 and 22 have been similarly amended to include a connector adapted to transmit RF signals and a DC offset indicative of the presence of the booster unit. Advantages of such an arrangement, it will be recalled, include ease of connectivity, and avoidance of inadvertent failure to notify the modem of the presence of the booster unit, which failure can lead to damage of the device. As discussed above, these features are not disclosed or suggested in Hanawa et al. and Barber, considered singularly or in combination, and the rejection based on these references is therefore improper and should be withdrawn.

Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

Conclusion


In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully solicited.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Please charge any additional required fee, including those necessary to obtain extensions of time to render timely the filing of the instant Reply, or credit any overpayment not otherwise paid or credited, to our deposit account No. 50-1698.

Respectfully submitted,
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